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TRANSMITTAL FORM (to be used for all correspondence after initial filing)	Application Number	10/077,718
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	First Named Inventor	Daniel Bone, et al.
	Art Unit	3724
	Examiner Name	Clark F. Dexter
Total Number of Pages in This Submission	Attorney Docket Number	0275S-000327/DVA

ENCLOSURES (check all that apply)

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SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm or Individual name	Harness, Dickey & Pierce, P.L.C.	Attorney Name Michael J. Schmidt	Reg. No. 34,007
Signature			
Date	June 9, 2005		

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 20

Application Number: 10/077,718
Filing Date: February 15, 2002
Appellant(s): Bone, et al.

Michael J. Schmidt

For Appellant

APPELLANT'S REPLY BRIEF



APPELLANT'S REPLY BRIEF

In response to the Examiner's Answer mailed April 25, 2005, please consider the following.

In section 11, page 5, the Examiner admits that Stoll is directed to a foot rest and is not disclosed as being or including a clamping mechanism. Even though the Examiner agrees that Stoll has nothing to do with a clamping mechanism, the Examiner still looks to Stoll to find the supporting surfaces for engaging the object. The Examiner on page 6, line 3 states that "Stoll does disclose the supporting surfaces" even though the Examiner concedes that Stoll is not directed as being or including a clamping mechanism.

The only way possible for the Examiner to look to Stoll and to find two supporting surfaces for clamping an object is to utilize hindsight gleaned from Applicants' disclosure.

The Examiner then goes on to say that "The device of Stoll could clearly operate as a foot rest, and then temporarily be used to clamp an object for cutting the object or the like."

Applicants submit that the proper test for evaluating prior art under 35 U.S.C. Section 103 is whether or not the prior art can be seen as suggesting the Applicants' solution to the problem which the invention addresses. See: Rosemont, Inc. v Beckman Instrument, Inc., 221 USPQ 1, 7 (Fed. Cir. 1984). The scope of pertinent prior art has been defined as that reasonably pertinent to the particular problem with which the inventor was involved. See: Lindemann Machinefabrik GMBH v. American Hoist and Derrick Co., 221 USPQ 481, 487 (Fed. Cir. 1984). Applicants assert that the use of hindsight in picking and choosing isolated elements from various pieces to the problems addressed by

Applicants' invention is improper according to the above-discussed judicial standards governing the proper application of 35 U.S.C. Section 103.

In Lindemann, supra, in reversing a district court holding of invalidity of certain patent claims under Section 103, the C.A.F.C. indicated in relevant part:

"The district court defined the problem here broadly, ie., as the problem of compressing waste materials. That finding is clearly erroneous. The inventors' problem was the crushing of massive metal scrap. Nothing in the prior art relied on as invalidating had any relation whatever to the crushing of massive metal scrap." 221 USPQ at 487.

The Court in Lindemann also later observed:

"The '315 patent [in suit] specifically stated that it disclosed and claimed a combination of features previously used in two separate devices. That fact alone is not fatal to patentability. The claimed invention must be considered as a whole, and the question is whether there is something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination. ...That question must here be answered in the negative.

"Nothing in the references alone or together suggests the claimed combination as a solution to the problem of crushing rigidly massive scrap." 221 USPQ at 488.

In a recent decision of the C.A.F.C., Panduit Corp. v. Dennison Manufacturing Co., 810 F2d 1561, 1 USPQ 2d 1593 (Fed. Cir. 1987), Chief Judge Markey discussed and applied the various judicial pronouncements summarized above in reversing a lower court's holding of invalidity based on obviousness under Section 103, and further cautioned against the impermissible use of hindsight in picking and choosing isolated elements from the prior art, which bear little or no relationship to each other or to the

problems addressed by the Applicants' invention, in reconstructing the claimed invention from the Applicants' own disclosure.

In the Panduit decision, Chief Judge Markey offered the opinion that such impermissible hindsight reconstruction from isolated elements in the prior art in order to arrive at the claimed combination is contrary to the purpose of the patent laws.

"Virtually all inventions are necessarily combinations of old elements. The notion, therefore, that combination claims can be declared invalid merely upon finding similar elements in separate prior patents would necessarily destroy virtually all patents and cannot be the law under the statute, Section 103." 810 F2d at 1575, 1 USPQ 2d at 1603.

Further, in the Panduit decision, Judge Markey discussed the fact that the large body of prior art, individual pieces of which show various bits and pieces of the claimed combination, can actually support a conclusion of non-obviousness, rather than serving as a basis for hindsight bit-by-bit reconstruction of the claimed invention.

"Indeed, that the elements noted by the court lay about in the prior art available for years to all skilled workers, without, as the court found, suggesting anything like the claimed inventions, is itself evidence of non-obviousness. ...[The court] nowhere reconciled [its] evaluations with its contrary findings that no one skilled in the art had for years been led to those evaluations by the prior art." 810 F2d at 1577-78, 1 USPQ 2d at 1605.

Judge Markey's opinion also addressed the hindsight picking and choosing problem accordingly:

"The district court nowhere pointed to anything in the prior art that would have suggested the desirability, and thus the obviousness, of making the distinctive structural elements and combinations...invented and claimed.

Nor did the court succeed in the difficult task of casting its mind back into that of a person of ordinary skill in the art that had no pre-knowledge of the crucial structural differences that vitalize [the] inventions." 810 F2d at 1580, 1 USPQ 2d at 1606 (emphasis in the court's opinion).

In the present application, the cited reference relates to problems that are quite distinct from the specific problems addressed by Applicants' claimed invention. Thus, it appears that at the time the invention was made, one skilled in the art would not have looked to this reference in order to solve these problems, at least as these problems are addressed by Applicants' claimed invention.

The Examiner first concedes that Stoll has nothing to do with a clamping mechanism but then continues his rejection based upon his assumption that it is possible to use Stoll as a clamping mechanism and a stool. The Examiner has clearly resorted to the improper use of hindsight to justify the rejection and this hindsight reconstruction has been judicially held to be impermissible both by the C.C.P.A. and the C.A.F.C.

CONCLUSION

Applicants respectfully submit that the prior art does not disclose all of the limitations of the pending claims and that the Examiner has not presented a prima facie case of obviousness for modifying the reference to obtain Applicants' claimed invention.

Applicants' invention provides the art with a self-actuating clamping mechanism which is neither disclosed, suggested or taught by the prior art. Accordingly, reversal of the final rejection of Claim 22 and 23 and the allowance of Claims 22-24 along with the rejoinder and allowance of Claims 25-28 is respectfully requested.

Respectfully submitted,

Dated: June 9, 2005

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